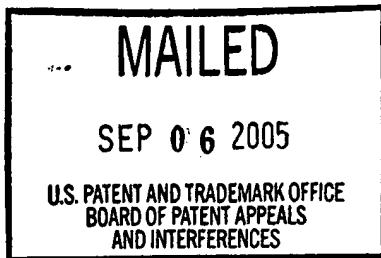


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ROGER MASSEY



Appeal No. 2005-1843
Application No. 09/585,222

ON BRIEF

Before McQUADE, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 3 and 5 to 8, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates generally to barstock body valves and the size of barstock required, and particularly to the size and weight reduction achievable through eccentric (or off-center) machining of the barstock to create the valve body's flow passage. An eccentrically located flow passage results in a thinner wall adjacent to the flow passage, and an initially smaller barstock size (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Matousek	4,026,516	May 31, 1977
Dicky	5,944,055	Aug. 31, 1999

The rejections set forth in the final rejection (mailed January 28, 2005) are as follows:

Claims 1, 2, 5 and 7 under 35 U.S.C. § 102(b) as being anticipated by Matousek;

Claim 6 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Matousek; and

Claims 3 and 8 under 35 U.S.C. § 103 as being unpatentable over Matousek in view of Dicky.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection and the answer (mailed January 28, 2005) for the examiner's complete reasoning in support of the rejections, and to the brief (filed October 1, 2004) and reply brief (filed March 28, 2005) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Claims 1, 2, 5 and 7

We will not sustain the rejection of claims 1, 2, 5 and 7 under 35 U.S.C. § 102(b) as being anticipated by Matousek.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference

anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Independent claims 1 and 7 read as follows:

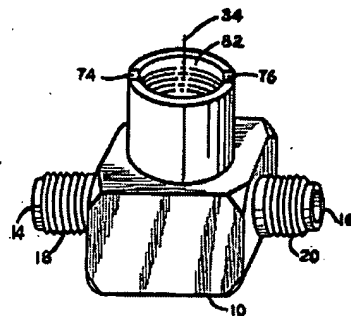
1. A barstock body fluid control valve comprising:
 - a barstock body of preselected material having an inlet end and an outlet end, and a substantially uniform transverse cross-section defining the outer walls;
 - a through machined main flow port located eccentrically on said inlet and said outlet ends;
 - wherein said main flow port eccentric location increases the available barstock thickness at one outer wall location and decreases barstock thickness in the opposite wall.
7. A two port fluid control valve comprising:
 - a barstock body having outerwalls extending between an inlet end and an outlet end defined by a substantially uniform transverse cross-section circumscribed about a central longitudinal axis;
 - a machined through bore extending between the inlet end and the outlet end of the barstock body about an offset longitudinal throughbore axis parallel spaced from the central longitudinal axis,
 - the through bore is eccentrically located with respect to the outer walls producing a thicker outerwall portion and a relatively thinner opposite wall portion of the barstock body; and
 - wherein a stem port communicates perpendicularly with said throughbore machined through said thicker outer wall portion of the barstock body.

Matousek's invention is directed to an improved ball valve of the type having the ball encapsulated in a resilient, resinous seal. Figure 1 is a longitudinal cross-section through a preferred embodiment of Matousek's invention. Figure 2 is a cross-sectional view taken on line 2--2 of Figure 1. Figure 3 is an enlargement of the circled portion of Figure 2. Figure 4 is an exploded pictorial view of the valve shown in Figure 1. Figures 1-4 illustrate a ball valve which includes a housing 10 defining an internal valve chamber 12 and inlet and outlet flow passageways 14 and 16. The internal valve chamber is cylindrical and extends axially into the housing 10. The inlet and outlet flow passages 14 and 16 are also cylindrical and intersect valve chamber 12 at right angles. Matousek teaches (column 2, lines 59-64) that:

the valve housing 10 is a one-piece body generally referred to as a "bar stock". That is, it is machined from a single piece of material such as brass, stainless steel or the like. Obviously, the housing could be of many types such as the standard cast and/or multi-piece housings.

The finished shape of housing 10 is best depicted in the exploded pictorial view of

Figure 4 as follows:



Positioned within Matousek's valve chamber 12 and arranged to control the flow between the inlet and outlet passages 14 and 16, is a ball valve element 22. An integrally formed operating stem 26 extends outwardly of the ball valve element 22. A valve operating handle 66 is operatively connected to the operating stem 26 to operate the ball valve element 22. Matousek teaches (column 3, lines 2-7) that:

It is to be understood that although the valve is shown as a standard straight through flow valve, it could, within the scope of the invention, have other flow patterns and, for example, be a three-way valve with a Y flow pattern or other more complex flow arrangements.

The appellant argues that claim 1 is not anticipated by Matousek since Matousek's housing 10 is not a barstock body having a substantially uniform transverse cross-section defining the outer walls. We agree. As shown in Figures 1-4, Matousek's housing 10 does not have a substantially uniform transverse cross-section defining the outer walls due to the presence of the upper end of valve chamber 12 in which the operating stem 26 is situated. While Matousek's housing 10 may well be formed from a barstock material originally having a substantially uniform transverse cross-section defining the outer walls, the finished housing 10 (i.e., after machining) does not have a substantially uniform transverse cross-section defining the outer walls.

The appellant argues that claim 7 is not anticipated by Matousek since Matousek's housing 10 is not a barstock body having outerwalls defined by a substantially uniform transverse cross-section circumscribed about a central longitudinal axis. We agree for the reasons set forth above with respect to claim 1.

For the reasons set forth above, the decision of the examiner to reject independent claims 1 and 7, and claims 2 and 5 dependent thereon, under 35 U.S.C. § 102(b) is reversed.

Claim 6

We will not sustain the rejection of claim 6 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Matousek.

Claim 6 reads as follows:

A method of forming a barstock body fluid control valve using reduced barstock size and a standard size valve stem, the method comprising the steps of:

- selecting the reduced size barstock having a substantially uniform transverse cross-section defining an outerwall configuration formed about a longitudinal center line and cutting the reduced barstock size to length;
- forming a valve body by machining flat surfaced ends on said reduced barstock size perpendicular to said barstock outer wall;
- defining a throughbore axis offset from and parallel to the longitudinal centerline of the barstock;

machining a throughbore in said barstock symmetrically about the offset throughbore axis to produce an eccentrically located throughbore defining a thicker portion and a thinner portion of said barstock outer wall;

machining a valve stem bore perpendicular to said throughbore in the thicker portion of the barstock outer wall located a maximum distance from said offset throughbore axis;

selecting a standard size valve stem to be inserted in the valve stem bore in the thicker portion of the barstock outer wall resulting in the thinner portion of the barstock wall positioned opposite the valve stem; and

installing the standard size valve stem in said valve stem bore.

The sole basis for this rejection as set forth in the final rejection (p. 3) is that "[t]he method of making is either inherent or obvious in view of Matousek's machined valve."

The method of claim 6 is not inherent from Matousek's ball valve. In that regard, it is not inherent¹ that Matousek's operating stem 26 be a standard size valve stem. As such, claim 6 is not anticipated by Matousek.

¹ It is well-settled that under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). As the court stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)(quoting Hansgirk v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

As to the method of claim 6 being obvious from Matousek's ball valve, we note that the examiner has not established a prima facie case of obviousness.² A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). In this case, the examiner has presented no evidence that would have led one of ordinary skill in the art to have modified Matousek so as to arrive at the method of claim 6.

For the reasons set forth above, the decision of the examiner to reject claim 6 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Matousek is reversed.

Claims 3 and 8

We have reviewed the reference to Dicky applied in the rejection of claims 3 and 8 but find nothing therein which makes up for the deficiencies of Matousek discussed

² In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

above with respect to claims 1 and 7.³ Accordingly, we cannot sustain the examiner's rejection of appealed claims 3 and 8 under 35 U.S.C. § 103 as being unpatentable over Matousek in view of Dicky.

CONCLUSION


To summarize, the decision of the examiner to reject claims 1, 2, 5 and 7 under 35 U.S.C. § 102(b) as being anticipated by Matousek is reversed; the decision of the examiner to reject claim 6 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Matousek is reversed; and the

³ Claim 3 depends from claim 1 and independent claim 8 includes the same limitation as claim 7 not taught by Matousek (i.e., a valve including a barstock body having outerwalls defined by a substantially uniform transverse cross-section circumscribed about a central longitudinal axis).

decision of the examiner to reject claims 3 and 8 under 35 U.S.C. § 103 as being unpatentable over Matousek in view of Dicky is reversed.

REVERSED


JOHN P. McQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

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